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10/619,511

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|-------------------------------------|--|
| Office Action Summary | Application No. 10/619,511 | Applicant(s) KATOH ET AL. | |
| | Examiner Patricia L. Nordmeyer | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 11-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2008 has been entered.

Withdrawn Rejections

2. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments in the response dated September 20, 2008.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 4, 7 – 9, 11 – 14 and 16 – 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wherein the second surface of the base material corresponding to the principally used portion of the adhesive is of a material selected from the group consisting of" in

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claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language if the base material is two different materials as the limitation above refers only to the second surface of the base material being a material selected from the listed group.

The phrase "wherein the back surface of the release sheet corresponding to the principally used portion of the adhesive is of a material selected from the group consisting of" in claim 3 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language if the base material is two different materials as the limitation above refers only to the second surface of the base material being a material selected from the listed group.

Claims 2, 4, 7 – 9, 11 – 14 and 16 – 22 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward et al. (USPN 5,384,174).

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Ward et al. disclose a laminate sheet (Figures 1 and 3) comprising: a long release sheet (Figure 3, #3); an adhesive layer in continuous direct contact and coextensive with the release surface of the long release sheet (Figure 3, #2); a base material having a first surface and a second surface (Figure 3, #1), the first surface being opposite to the second surface (Figure 3, #1), the first surface being in continuous direct contact and coextensive with the adhesive layer opposite to the long release sheet (Figure 3, #1 and 2), the base material being of a different material than the adhesive layer (Column 3, lines 9 – 23 and lines 34 - 43); and a protective material provided longitudinally on and in continuous direct contact with a generally peripheral portion of the second surface of the base material (Figure 3, #4; Figure 4, #14; Column 6, lines 37 - 50), wherein the peripheral portion corresponds to a portion other than a principally used portion of the adhesive layer (Figure 4, #14), wherein the protective material is provided as first and second portions thereof (Figure 4, #14), only on first and second sides of the second surface of the base material, the first and second portions being spaced apart in the widthwise direction thereof (Figure 4, #14), and the first and second portions defining a void there between (Figure 4, #13), wherein the second surface of the base material corresponding to the principally used portion of the adhesive is polyamide (Column 3, line 18) or wherein the back surface of the release sheet between the protective material is polyamide (Column 3, line 18) as in claim 1. With regards to claim 2, a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer (Column 6, lines 51 - 58). As in claims 8 and 9, the protective material has a band-like shape (Figure 4, #14) and a uniform width (Figure 4, #14), or the protective material has a shape with an edge adjacent to the principally-used portion (Figure 4, #14).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 4, 13, 14 and 17 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. (USPN 5,384,174) in view of Benecke et al. (USPN 5,008,110).

Ward et al. disclose a laminate sheet (Figures 1 and 3) comprising: a long release sheet (Figure 3, #3); an adhesive layer in continuous direct contact and coextensive with the release surface of the long release sheet (Figure 3, #2); a base material having a first surface and a second surface (Figure 3, #1), the first surface being opposite to the second surface (Figure 3, #1), the first surface being in continuous direct contact and coextensive with the adhesive layer opposite to the long release sheet (Figure 3, #1 and 2), the base material being of a different material than the adhesive layer (Column 3, lines 9 – 23 and lines 34 - 43); and a protective material provided longitudinally on and in continuous direct contact with a generally peripheral portion of the second surface of the base material (Figure 3, #4; Figure 4, #14; Column 6, lines 37 - 50), wherein the peripheral portion corresponds to a portion other than a principally used portion of the adhesive layer (Figure 4, #14), wherein the protective material is provided as first and second portions thereof (Figure 4, #14), only on first and second sides of the second surface of the base material, the first and second portions being spaced apart in the widthwise direction thereof (Figure 4, #14), and the first and second portions defining a void there between (Figure 4,

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#13), wherein the second surface of the base material corresponding to the principally used portion of the adhesive is polyamide (Column 3, line 18) or wherein the back surface of the release sheet between the protective material is polyamide (Column 3, line 18) as in claim 3.

With regards to claim 4, a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer (Column 6, lines 51 - 58). As in claims 13 and 14, the protective material has a band-like shape (Figure 4, #14) and a uniform width (Figure 4, #14), or the protective material has a shape with an edge adjacent to the principally-used portion (Figure 4, #14). Regarding claims 18 and 20, the base material is a release treated paper (Column 5, lines 48 – 49). However, Ward et al. fail to disclose the back surface of the release sheet selected from polyethylene terephthalate, polypropylene, glassine paper, clay-coated paper and laminated paper and wherein the base material is made of polycarbonate, poly (methyl methacrylate) or polystyrene.

Benecke et al. teaches a laminate sheet (Figure 1) wherein the back surface of the release sheet selected from polyethylene terephthalate (Column 6, lines 49 – 56), wherein the base material is made of polystyrene (Column 11, lines 34 – 46) for the purpose of protecting the laminated item from environmental factors (Column 3, lines 37 – 39).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyethylene terephthalate release sheet and

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polystyrene base material in Ward et al. in order to protect the laminated item from environmental factors as taught by Benecke et al.

9. Claims 7, 11, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. (USPN 5,384,174) in view of Benecke et al. (USPN 5,008,110) as applied to claims 3, 4, 13, 14 and 17 - 20 above, and further in view of Rogers et al. (USPN 5,376,418).

Ward et al., as modified with Benecke et al., disclose the claimed laminate sheet except for when the laminate sheet is wound into a roll, the protective material serves as a spacer between the base material and the long release sheet and wherein a thickness of the protective material is between 5 μ m and 100 μ m.

Rogers et al. teach that it is known to place laminate sheets (Figure 1, #12) onto a release material wound into a roll (Figure) for the purpose of protecting an image on the laminate structure (Column 2, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the laminate in a roll in Ward et al. in order to protect an image on the laminate structure as taught by Rogers et al. Therefore, the protective material serves as a spacer between the base material and the long release sheet.

Ward et al., as discussed above, fails to expressly teach that the thickness of the protective material is between 5 and 100 microns. It would have been obvious to one having ordinary skill in the art to provide Ward's laminate to have a 5-100 microns

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protective material because it is well known and conventional in the adhesive art to provide protective material covering the adhesive to have a thickness of between 5 and 100 microns, based on optimization through routine experimentation, for minimizing cost as the protective material is discarded as waste.

Response to Arguments

10. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive.

In response to Applicant's argument that Ward et al. fails to disclose the protective material existing only on the first and second sides of the backing layer, Ward et al. does disclose the protective material existing only on the first and second sides of the backing layer (Figure 4, #14), as the protective material is spaced apart from each other. There is nothing stated in the claim language that the two sides cannot touch.

In response to applicant's argument that Ward et al. has a different intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

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Primary Examiner, Art Unit 1794